

REMARKS

No claims have been amended by this response. Reconsideration of this application and allowance of all claims is respectfully requested.

Turning to the Office Action, claims 1-4, 6-9, 11-17, 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stengel (5109530) and Lemelson (4354189). Further, claims 5, 10 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stengel and Lemelson as applied to claims 1, 8 and 15, and further in view of Stamn (4353064).

Applicants respectfully assert that these rejections are improper for the following reasons. As set forth in the MPEP, it is the prior art, and not the Examiner, that must suggest the desirability of the claimed invention. See MPEP § 2143.01. Accordingly, passage of all rejected claims to issue is requested because no suggestion regarding the desirability of the claimed invention is provided by the prior art of record.

A patent claim is obvious when the differences between the claimed invention and the prior art “are such that the subject matter as a whole have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103; see also Graham v. John Deere Co., 383 U.S. 1, 14, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966); In re Dembiczak, 175 F.3d 994, 998 (Fed. Cir. 1999). While obviousness is ultimately a legal determination, it is based on several underlying issues of fact, namely: (1) the scope and content of the prior art; (2) the level of skill of a person of ordinary skill in the art; (3) the differences between the claimed invention and the teachings of the prior art; and (4) the extent of any objective indicia of non-obviousness. See Graham, 383 U.S. at 17-18. When obviousness is based on the teachings of multiple prior art references, it must also be established that some “suggestion, teaching, or motivation” would have led a person of ordinary skill in the art to combine the relevant prior art teachings in the manner claimed. See Tec Air, Inc. v. Denso Mfg. Mich. Inc., 192 F.3d 1353, 1359-60 (Fed. Cir. 1999); Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1572 (Fed. Cir. 1996). A prima facie showing of obviousness may be rebutted with evidence refuting that there is a “suggestion, teaching, or motivation” or with other objective evidence of nonobviousness. See WMS Gaming, Inc. v. Int’l Game Tech., 184 F.3d 1339, 1359 (Fed. Cir. 1999).

“The reason, suggestion, or motivation to combine [prior art references] may be found

explicitly or implicitly: 1) in the prior art references themselves; 2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, “leading inventors to look to references relating to possible solutions to that problem.” Ruiz v. A.B. Chance Co., 234 F.3d 654, 665 (Fed. Cir. 2000) (quoting Pro-Mold, 75 F.3d at 1572). The “case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” Dembiczak, 175 F.3d at 999; *see also* Ruiz, 234 F.3d at 665. This is because “[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight.” Dembiczak, 175 F.3d at 999. Therefore, it has been consistently held that a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but some motivation to combine the prior art teachings in the particular manner claimed. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (“Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” (emphasis added)); *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (“In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” (emphasis added)).

Turning back to the rejection of the present claims-at-issue, it is stated in the Office Action that “Lemelson shows an unlocking device where a receiver in the reader receives a reply signal from a coded ring, but does not specifically show the power controlling modes claimed.” As also stated in the Office Action, “[i]n the analogous art, Stengel teaches a method that is used to save power in a receiver.” As then explained, “Stengel’s receiver deactivates a circuit for a first time period (tx) in step 310. The receiver then enables the circuit for a second time period in step 304. Upon sensing an electromagnetic signal during the second time period, the enabling is extended for a greater time (ty) step 320. The received signal can then be processed because it will be received in its entirety during the extended time.” As then concluded in the Office Action, “[t]his

method saves power in the receiver system.”

Applicants disagree with the statement that Lemelson “does not specifically show the power controlling modes claimed.” Instead, Applicants assert that Lemelson completely fails to show any automated power controlling modes whatsoever. As a result, Lemelson suffers from the very same problem that is solved by the present application – excessive power consumption of an unlocking device. Accordingly, one skilled in the art would not be motivated to use Lemelson for implementing the power controlling modes as set forth in the present application because the problem is not recognized or addressed by Lemelson.

The reliance on Stengel to correct the failings of Lemelson is misplaced. Stengel is directed to a radio receiver having a squelch operated battery saver. Clearly, the radio receiver of Stengel for transmission of voice signals does not relate to unlocking devices. Therefore, like Lemelson, Stengel does not address the problem of excessive power consumption within unlocking devices. Accordingly, Applicant respectfully requests that the rejections based on Stengel and Lemelson be withdrawn because the Office Action does not include rationale why a skilled artisan, confronted with the same problems as the Applicants and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

Applicants further assert that Stamm does not correct the shortcomings of Stengel and Lemelson regarding the excessive power consumption within prior unlocking devices. Further, Stamm does not teach or suggest using infrared within an unlocking device that is periodically enabled to receive an input. Thus, withdrawal of the rejections based in part on Stamm is respectfully requested.

In view of the above remarks, Applicants respectfully request that all pending claims be passed to issue.

Should anything further be required, a telephone call to the undersigned at (312) 226-1818 is respectfully solicited.

Dated: September 27, 2005

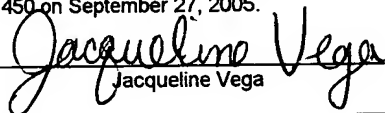
Respectfully Submitted,



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